

Appl. No. : 09/510,500  
Filed : February 22, 2000

### REMARKS

The foregoing Amendment is responsive to the Office Action mailed on December 8, 2003. Applicants' representative would like to initially thank Examiners Matthew Ludwig and Stephen Hong for the courtesy they extended during the interview conducted on January 22, 2003.

By the foregoing Amendment, Applicants have amended the claims along the lines discussed during the interview, and have added new claims to the application. No new matter has been added. Each independent claim is discussed below.

#### Independent Claim 1

Claim 1 has been amended to recite that the clickable icon file is selected, by a server, to correspond to a profile of the user of the personal computer. As discussed during the interview, one application for this feature is to provide targeted marketing on the desktops of users who use the wallpaper desktop program. For example, as recited in some of the new dependent claims, icons the serve as links to specific web sites may be selected to display on users' desktops based on the disclosed wallpaper download histories, wallpaper search histories, and/or other preferences of users. See Claims 23-26, and the associated description at, e.g., page 26, line 1 to page 28, line 12.

The applied references, namely Chrabaszcz (U.S. Patent 6,101,529) and Straub et. al. (U.S. Patent 5,905,492), do not disclose or suggest selecting a clickable icon to display on a desktop based on a user's profile, within the context of the other claim limitations. The amendment to Claim 1 is therefore believed to render Claim 1, and its dependent claims, patentable over the applied references.

In response to the Examiner's objection to the language "but not generally unremovable" in Claim 1, Applicants have replaced this language with an indication that the clickable icon is "persistently displayed on a desktop of the personal computer within the wallpaper image." As discussed during the interview, ads that are displayed within web pages are not "persistently displayed on a desktop."

Applicants also wish to point out that the "not generally unremovable" language removed from Claim 1 refers generally to a feature in which the icon, or other clickable image, is

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embedded within the wallpaper image, rather than being overlaid on the wallpaper as is conventional. This feature, which inhibits removal of the clickable image by the user, is described, e.g., at page 28, line 14 to page 29, line 4 of the application. Other pending claims are directed to aspects of this feature (see Claims 2, 31, and 50-54).

#### Independent Claim 6

As suggested by Examiner Ludwig, Applicants have amended the last sub-paragraph of independent Claim 6 to use more definite language regarding the option to purchase. Applicants have also amended the same sub-paragraph to replace “a hard copy of the wallpaper image” with “an item associated with said wallpaper image.” New dependent Claim 21 recites that the item is “a hard copy of the wallpaper image,” and new dependent Claim 22 recites that the item is “a physical poster or a print containing the wallpaper image.”

As discussed during the interview, the applied references do not disclose or suggest providing, within a wallpaper image, a link to a web site that provides an option to purchase a hard copy of the wallpaper image. Applicants also submit that the applied references do not disclose or suggest providing such a link for purchasing other types of items associated with the wallpaper image. The rejection of Claim 6, and its dependent claims, is therefore improper.

#### Independent Claim 30

New independent Claim 30 includes limitations relating to the use of wallpaper preferences of a user to select a clickable image to display on a desktop of the user’s computer. As these limitations are not disclosed or suggested by the applied references, Claim 30 and its dependent claims are believed to be patentable over the applied references.

#### Independent Claim 43

New independent Claim 43 is directed to a system in which preferences of users of a database of wallpaper images are used by a comparison program to select target users to which a clickable image is to be displayed within desktop wallpaper. As the applied references do not disclose or suggest a system as defined in Claim 43, Claim 43 and its dependent claims are believed to be patentable over the applied references.

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#### Independent Claim 48

New independent Claim 48 includes all of the limitations of dependent Claim 10, as originally presented, including the base claim and all intervening claims. Because the Examiner indicated in the Office Action that Claim 10 was directed to allowable subject matter, Claim 48 and its dependent claims are believed to be allowable.

#### Independent Claim 51

New independent Claim 51 requires that the selected clickable image be embedded within the wallpaper image by combining file code of a clickable image file with file code of a wallpaper image file. An important aspect of this feature is that it inhibits removal of the icon, or other clickable image, from the desktop by the user. In contrast, prior art methods for displaying desktop icons ordinarily involve superimposing or overlaying the icon on the wallpaper image, such that the icons can be removed from the desktop without switching to a different wallpaper image.

The cited references do not disclose or suggest embedding a clickable image within a wallpaper image within the context of the other limitations of Claim 51. Claim 51 and its dependent claims are therefore patentable over the cited references.

#### Dependent Claims

Additional patentable distinctions over the applied references are recited throughout the dependent claims. By way of example and not limitation, dependent Claims 24 and 33 recite the use of users' wallpaper image download histories as a basis for selecting clickable images or icons to present to users. This feature is not disclosed or suggested by the applied references.

#### Conclusion

In view of the foregoing amendments and remarks, Applicants submit that the claims are patentably distinct from the applied references, and request that the application be allowed.



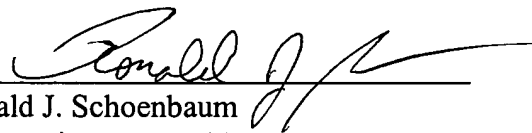
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If any issues remain which can potentially be resolved by telephone, the Examiner is requested to call the undersigned attorney of record at his direct dial number of 949-721-2950.

Respectfully submitted,

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